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10/657,409	09/08/2003	Anthony J. Baerlocher	0112300-1631	9937

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EXAMINER

PINHEIRO, JASON PAUL

ART UNIT	PAPER NUMBER
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3714

NOTIFICATION DATE	DELIVERY MODE
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09/15/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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PATENTS@BELLBOYD.COM

Office Action Summary

Application No.

10/657,409

Applicant(s)

BAERLOCHER ET AL.

Examiner

Jason Pinheiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. After the amendments filed 06/20/2008, claim 1 was amended, therefore claims 1-20 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. **Claims 1-4,12-14 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama (US 4,716,529), Brown et al. (US 7,018,293 B2) and further in view of "Endgame Tablebase" (Wikipedia.org).**

Regarding claim 1, Nakayama discloses a method of operating a gaming device, said method comprising displaying a playing board having a plurality of positions (Fig. 1), enabling each of a plurality of chips to be placed individually at one of the positions,

the chips being either game chips or player chips, wherein placement of one of the game chips that causes at least one player chip to be flanked on opposite sides by the game chips converts each said flanked player chip to a game chip, and wherein placement of one of the player chips that causes at least one game chip to be flanked on opposite sides by player chips converts each said flanked game chip to a player chip (col. 2, lines 42-50; col. 4, lines 32-63).

Nakayama does not specifically disclose using a table in memory to place at least one game chip at one of the positions, wherein the table is weighted according to a designated target number of player chips remaining after a player places each of a provided amount of player chips onto the positions, wherein the designated target number of player chips is randomly determined and greater than zero. However, Nakayama discloses using a piece position data memory (i.e. a table) to determine the position at which the computer places a gaming chip in response to a player placing a player chip (col. 4, lines 49-55). Game chip placement as determined by the computer may be influenced by, i.e. weighted according to, a selected level of difficulty. The selected level of difficulty creates a desired advantage of the computer relative to the player, similar to the desired advantage of the computer relative to the player created by determining game chip placement according to a total number of player chips remaining at the conclusion of the game. For instance, an embodiment of the invention of claim 1 wherein a desired total number of player chips remaining at the end of the game are ten would be relatively more difficult than an embodiment wherein a desired total number of player chips remaining at the end of the game is one.

Additionally, "Endgame Tablebase" discloses a method for determining a game piece move based upon a desired number of player pieces remaining at the end of the game. That is, an endgame tablebase allows a computer opponent to make an optimal move of a game piece in order to achieve a desired arrangement of game and player pieces at the conclusion of the game (P. 1). Although Endgame does not specifically disclose that the designated target at the conclusion of the game is randomly determined, it would have been obvious to one skilled in the art at the time of the invention that after the player randomly places each player chip, the situation presented to the computer is randomly changed. Thusly, the computer must then randomly determine a designated number player chips to be remaining, in light of the current situation, in order to optimally place it's next game chip to minimize the number player pieces remaining after the game chip is placed (P. 1) , and thusly randomly changes the designated number of player pieces the computer would need there to be at the Endgame in order to achieve its goal of defeating the player opponent (P. 1). Endgame databases were proposed by Richard Bellman in 1965 to solve chess and checkers endgames (P. 3). While the primary application for endgame tablebases disclosed in "Endgame Tablebase" is a chess game, the background paragraph of "Endgame Tablebase" discloses that it is possible to solve any game under the condition that the complete state is known and there is no random chance, including games such as Tic Tac Toe, Connect Four and Checkers (P. 2-3). These games are strategy-type skill games analogous to the chip-conversion game of Nakayama. Therefore, to apply the endgame tablebase piece movement algorithms to the chip-conversion game of

Nakayama would have been obvious to one of ordinary skill in the art at the time of the invention.

Nakayama does not specifically disclose awarding the player based on the remaining number of player chips after the player placed the provided amount of player chips onto the positions. Nakayama does not disclose providing an award to the winning player. However, in an analogous chip conversion type game, Brown discloses awarding the player based on the remaining number of player chips after the player placed the provided amount of player chips onto the positions (Table 8, wherein Number of Pieces at end of bonus round determines bonus award pay; col. 31, lines 13-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the chip conversion game taught by Nakayama with the award payout method taught by Brown as Brown discloses an embodiment of the chip conversion game to be used for personal entertainment purposes, i.e. on a home computer or Game Boy™ device, similar to the invention disclosed by Nakayama, in addition to a bonus game for use in a gaming machine that provides awards to participants. That is, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with a change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Regarding claim 2, Nakayama discloses placing an initial configuration of game and player chips on the board, leaving a plurality of possible positions to place

additional chips to thereby convert one of the initially placed chips (Fig. 4(1) - 4(5), showing possible game board configurations).

Regarding claim 3, Nakayama discloses generating one of the possible positions to be filled by one of the game chips to thereby convert one of the player chips to a game chip (col. 4, lines 48-51; col. 2, lines 47-50).

Regarding claim 4, Nakayama discloses enabling the player to select one of the possible positions to be filled by one of the player chips to thereby convert one of the game chips to a player chip (col. 2, lines 47-50; col. 4, lines 35-48).

Regarding claim 12, *Nakayama does not specifically disclose structuring the table to be particular to a previous placement of one of the player chips*. However, the game chip placement is based upon a previous placement of one of the player chips (col. 4, lines 48-55), which is the intended effect of structuring the table. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to structure the table, used to place at least one game chip at one of the positions, to be particular to a previous placement of one of the player chips as Nakayama discloses determining the placement of the game chip in accordance with the placement of a previously placed player chip.

Regarding claim 13, Nakayama discloses structuring the provided amount of player chips to be less than half of the total number of positions on the board (Fig. 4(1) - 4(5)).

Regarding claim 14, Nakayama discloses flanking the player chips on the opposite sides includes flanking the player chips in a diagonal, horizontal or vertical line

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with game chips. That is, Nakayama discloses only that a player chip be “sandwiched” between game chips in order to be converted (col. 2, lines 43-49) which may include being flanked in any of a diagonal, horizontal or vertical line.

Regarding claims 19 and 20, Brown discloses the game may be played via a data network, wherein the data network includes an internet (col. 3, lines 13-29), or a computer storage device.

3. Claims 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama (US 4,716,529), Brown (US 7,018,293 B2), “Endgame Tablebase” (Wikipedia.org) and further in view of Hughs-Baird et al. (US 6,439,995 B1).

Nakayama/Brown/“Endgame Tablebase” as combined above does not teach awarding the player based on a combination of values randomly associated with positions having the remaining player chips, associating the values individually with each of the positions prior to game play, and displaying the values to the player during game play such that the values of the positions having the remaining chips when the player chips are first displayed in the positions. Instead, Brown discloses awarding a player based upon the number of player chips remaining at the conclusion of the bonus round (bonus game payable **116**, Fig. 8-24; col. 11 lines 60-62). However, this method of awarding a player in a bonus game (wherein the award value is based on a combination of values associated with positions) is well known to one of ordinary skill in the art. Hughs-Baird teaches a bonus game wherein a player selects game board positions such that the resulting bonus game award value is a combination of said

selected positions (col. 3, lines 30-42). The values associated with the positions are randomly determined prior to the start of bonus game play (col. 5, lines 42-55), are revealed to the player during play of the bonus game (col. 6, lines 47-57), and include selecting the values from the group consisting of game credits, game credit multipliers, a number of free spins, a number of free games, a number of picks from a prize pool, a non-monetary award and any combination thereof (Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Nakayama, Brown and Hughs-Baird in order to provide a bonus game wherein awarding the player is based on a combination of values associated with positions having player chips as the inventions are analogous gaming devices in the same field of endeavor.

4. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakanyama (US 4,716,529), Brown (US 7,018,293 B2), "Endgame Tablebase" (Wikipedia.org) and further in view of Frost et al. (US 2002/0090988 A1).

Nakayama/Brown/"Endgame Tablebase" as combined above does not teach structuring the award to include a combination of values associated with the remaining player chips, displaying the values of the remaining player chips when the player chips are first displayed, providing player chips having display values to the player, nor display values associated with the player chips even after the associated player chips are converted to game chips. Instead, Brown discloses awarding a player based upon the number of player chips remaining at the conclusion of the bonus round (bonus game

paytable **116**, Fig. 8-24; col. 11 lines 60-62). However, this method of awarding a player in a game (wherein the award value is based on the combination of values associated with chips) is well known to one of ordinary skill in the art. Frost discloses a gaming device wherein a player may selectively place chips having an associated value on a board, i.e. a roulette game, as shown in Fig. 3. At the conclusion of the game, the combination of values associated with the chips determines the amount a player receives as an award (§ 0061, wherein multiple chips may be assigned to a single positions such that the total award value is a combination of said multiple chip values). It would have been obvious to combine the teachings of Nakayama, Brown and Frost in order to provide a game wherein awarding the layer is based on a combination of values associated with chips as the inventions are analogous gaming devices in the same field of endeavor.

Response to Arguments

5. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.
6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Pinheiro whose telephone number is (571)270-1350. The examiner can normally be reached on M - F 8:00 AM - 4 PM;.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

/J. P./
Examiner, Art Unit 3714